

ESTTA Tracking number: **ESTTA496574**

Filing date: **09/26/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Little Donkey's, Inc. DBA Panchero's, Inc.
Granted to Date of previous extension	09/26/2012
Address	2475 Coral Court, Suite B Coralville, IA 52241 UNITED STATES
Attorney information	Christopher J. Voci Simmons Perrine Moyer Bergman PLC 1100 - 5th Street, Suite 205 Coralville, IA 52241 UNITED STATES trademarks@simmonsperine.com Phone:319-354-1019

Applicant Information

Application No	85349661	Publication date	05/29/2012
Opposition Filing Date	09/26/2012	Opposition Period Ends	09/26/2012
Applicant	Little Donkey Taqueria, LLC 3755 Corporate Woods Dr. Birmingham, AL 35242 UNITED STATES		

Goods/Services Affected by Opposition

Class 043. All goods and services in the class are opposed, namely: Bar and restaurant services; Cafe and restaurant services; Carry-out restaurants; Fast-food restaurants and snackbars; Restaurant; Restaurant and bar services, including restaurant carryout services; Restaurant services, including sit-down service of food and take-out restaurant services; Restaurant services, namely, providing of food and beverages for consumption on and off the premises; Take-out restaurant services

Applicant Information

Application No	85350539	Publication date	05/29/2012
Opposition Filing Date	09/26/2012	Opposition Period Ends	
Applicant	Little Donkey Taqueria, LLC 3755 Corporate Woods Dr. Birmingham, AL 35242 UNITED STATES		

Goods/Services Affected by Opposition

Class 043.

All goods and services in the class are opposed, namely: Cafe and restaurant services; Cafe-restaurants; Carry-out restaurants; Fast food and non-stop restaurant services; Fast-food restaurants; Restaurant; Restaurant and bar services, including restaurant carryout services; Restaurant and cafe services; Restaurant services, including sit-down service of food and take-out restaurant services; Restaurant services, namely, providing of food and beverages for consumption on and off the premises; Restaurants; Take-out restaurant services

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	LITTLE DONKEYS INC. and LITTLE DONKEYS		
Goods/Services	Restaurant franchising services [035] and Restaurant services [043]		

Attachments	LITTLE DONKEYS opposition brief (final).PDF (5 pages)(48410 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Christopher J. Voci/
Name	Christopher J. Voci
Date	09/26/2012

IN THE UNITED STATES PATENT
AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL
AND APPEAL BOARD

In the matter of Application Serial Nos. 85349661 and 85350539

Little Donkeys, Inc. DBA Panchero's, Inc
Opposer,

v.

Opposition No.: To Be Assigned

Little Donkey Taqueria, LLC,
Applicant.

NOTICE OF OPPOSITION

Introduction

1. Little Donkeys, Inc. (Opposer's Tradename) DBA Panchero's, Inc, a company organized and existing under the laws of Illinois and having a business address at 2475 Coral Ct., Suite B, Coralville, IA, 52241 (Opposer), believes that it will be damaged by registration of applications owned by Little Donkey Taqueria, LLC's (Applicant).
2. Namely, Opposer will be damaged by registration of Application No. 85/349,661 for the word mark LITTLE DONKEY TAQUERIA, which covers services in Class 043 for "Bar and restaurant services; Cafe and restaurant services; Carry-out restaurants; Fast-food restaurants and snackbars; Restaurant; Restaurant and bar services, including restaurant carryout services; Restaurant services, including sit-down service of food and take-out restaurant services; Restaurant services, namely, providing of food and beverages for consumption on and off the premises; Take-out restaurant services."
3. In addition, Opposer will be damaged by registration of Application No. 85/350,539 for the logo mark LITTLE DONKEY A TACO REVIVAL, which covers services in Class 043 for "Cafe and restaurant services; Cafe-restaurants; Carry-out restaurants; Fast food and non-stop restaurant services; Fast-food restaurants; Restaurant; Restaurant and bar services, including restaurant carryout services; Restaurant and cafe services; Restaurant services, including sit-down service of food and take-out restaurant services; Restaurant services, namely, providing of food and beverages for consumption on and off the premises; Restaurants; Take-out restaurant services." Together LITTLE DONKEY TAQUERIA and LITTLE DONKEY A TACO REVIVAL are referred to as Applicant's Marks.

Opposer's Tradename

4. Opposer operates and has continuously operated under the tradename Little Donkeys, Inc. since formation of the corporation on January 17, 1992.
5. Under this tradename, Opposer has been in the business of operating Mexican restaurants with the Panchero's faceplate.
6. The first corporate owned Pancheros restaurants opened in July, 1992, in East Lansing, Michigan.

7. Opposer has spent considerable effort and money to grow the business operated under Opposer's Tradename. Opposer has successfully opened and operated numerous restaurants under the Pancheros faceplate. To wit, as of December 31, 2011, Opposer owns and operates 21 Panchero's locations in five states including Illinois, Iowa, Michigan, Minnesota and Wisconsin. Restaurant services are classified in Class 043. The use of Opposer's Tradename in this manner is continuous and ongoing.
8. Opposer also operates under this tradename in the business of franchising restaurants with the Panchero's faceplate.
9. The first franchisee owned Pancheros restaurant opened in April 2003, in Plymouth, Minnesota.
10. Opposer has spent considerable effort and money to grow the business operated under Opposer's Tradename. Opposer has successfully worked with numerous people and entities to open restaurants under the Pancheros faceplate. To wit, as of December 31, 2011, Opposer has 27 franchised locations operating in 16 states including Arizona, Colorado, Connecticut, Florida, Illinois, Iowa, Maryland, Minnesota, Nebraska, New Jersey, North Carolina, North Dakota, Pennsylvania, South Dakota, Virginia and Wisconsin. Restaurant franchising services are classified in Class 035. The use of Opposer's Tradename in this manner is continuous and ongoing.
11. Opposer is entitled to oppose Applicant's Marks on the basis of Opposer's Tradename alone.

Opposer's Trademark

12. To the extent that Opposer's Trademark has been used in commerce before May 4, 2011, Opposer owns common law trademark rights in Opposer's Trademark) in connection with restaurant services and in connection with restaurant franchising services. Such use is continuous and ongoing.
13. Opposer is entitled to oppose Applicant's Marks on the basis of common law trademark rights in Opposer's Trademark.

Opposer's Use of Tradename Analogous to Trademark Use

14. Opposer has used Opposer's Tradename in a manner analogous to a trademark use before May 4, 2011 by creating in customers' minds an association between Opposer's Tradename and the restaurant and restaurant franchising services provided under that tradename by the Opposer. Such use is continuous and ongoing.
15. Opposer is entitled to oppose Applicant's Marks on the basis of use of Opposer's Tradename in a manner analogous to a trademark use.

Applicant

16. Upon information and belief, Applicant is an Alabama limited liability company with an address at 3755 Corporate Woods Dr., Birmingham, AL, 35242.
17. Upon information and belief, Applicant was formed on or about May 4, 2011.

18. Upon information and belief, Applicant is managed by Fresh Holding, LLC, an Alabama limited liability company with an address at 3755 Corporate Woods Dr., Birmingham, AL, 35242.
19. Upon information and belief, Applicant is the record owner of Applicant's Marks.
20. Upon information and belief, Applicant adopted Little Donkey Tacqueria, LLC (Applicant's Tradename) tradename on or about May 4, 2011.

COUNT I: LIKELIHOOD OF CONFUSION

21. Opposer repeats and incorporates herein by reference the averments in the preceding paragraphs.
22. Applicant's Marks wholly incorporate Opposer's Tradename and create an overall commercial impression identical to that of Opposer's Tradename.
23. Applicant's Marks are identical in appearance and sound to Opposer's Tradename and create an overall commercial impression identical to that of Opposer's Tradename.
24. The services listed in the applications for Applicant's Mark's either directly overlap or are closely related to the services identified by Opposer's Tradename or Opposer's Trademark. On information and belief, the services in applications for Applicant's Marks are intended to be offered in the same channels of trade as those offered by Opposer under the Opposer's Tradename or Opposer's Trademark and are intended to be offered to the same class of consumers who purchase the services promoted by Opposer's Tradename or Opposer's Trademark.
25. The adoption of Opposer's Tradename predates the filing of both applications for Applicant's Mark. Opposer's Tradename was adopted on January 17, 1992, while the applications for Applicant's Marks were filed on June 17, 2011.
26. Opposer's date of first commercial use of Opposer's Trademark predates the filing date of both applications for Applicant's Marks, namely, prior to June 17, 2011.
27. Opposer's date of first use of Opposer's Tradename in a manner analogous to a trademark use predates the filing date of both applications for Applicant's Marks, namely, prior to June 17, 2011.
28. Upon information and belief, Opposer's adoption of Opposer's Tradename predates any commercial use by Applicant of the Applicant's Marks for the service recited in the opposed applications in the U.S.
29. Upon information and belief, Opposer's date of first commercial use of Opposer's Trademark predates any commercial use by Applicant of the Applicant's Marks for the service recited in the opposed applications in the U.S.
30. Upon information and belief, Opposer's date of first use of Opposer's Tradename in a manner analogous to a trademark use predates any commercial use by Applicant of the Applicant's Marks for the service recited in the opposed applications in the U.S.
31. The adoption of Opposer's Tradename predates the adoption of Applicant's Tradename. Opposer's Tradename was adopted on January 17, 1992, while Applicant's Tradename was adopted on or about May 4, 2011.

32. Upon information and belief, Opposer's date of first commercial use of Opposer's Trademark predates the adoption of Applicant's Tradename, namely, prior to May 4, 2011.

33. Upon information and belief, Opposer's date of first use of Opposer's Tradename in a manner analogous to a trademark use predates the adoption of Applicant's Tradename, namely, prior to May 4, 2011.

34. In light of the foregoing, Applicant's Marks, as used or proposed for use, on the services recited in the opposed application is confusingly similar to Opposer's Tradename and/or Opposer's Trademark and is likely to cause confusion and mistake, and to deceive the public into believing that Applicant's services originate from, or are in some way sponsored by, licensed by, associated with or otherwise authorized by Opposer in violation of Section 2(d) of the Lanham Act, 15 U.S.C.A. § 1052(d), resulting in damage to Opposer.

35. If Applicant is granted the registration herein proposed, it would thereby obtain a prima facie right to use the mark, which would be a further source of damage to Opposer.

PRAYER FOR RELIEF

WHEREFORE, Opposer respectfully requests that this Opposition be sustained and that Application Nos. 85/349,661 and 85/350,539 for the LITTLE DONKEY TAQUERIA and LITTLE DONKEY A TACO REVIVAL, respectively, marks be denied registration.

The necessary filing fee for this Notice of Opposition is being submitted electronically with this Notice.

Respectfully submitted,

Little Donkeys, Inc. DBA Pancheros

By Its Attorneys

A handwritten signature in black ink, appearing to read "Christopher J. Voci". The signature is written in a cursive, flowing style.

Christopher J. Voci

Simmons Perrine Moyer Bergman PLC

1100 - 5th Street, Suite 205

Coralville, IA 52241

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing NOTICE OF OPPOSITION is being deposited with the U.S. Postal Service with sufficient postage as first-class mail September 26, 2012 in an envelope addressed to Applicant's counsel of record at the following address:

Marcus Hunt

Duell Hunt, LLC

2803 Greystone Commercial Blvd Ste 12

Birmingham, Alabama 35242-9603